

REMARKS:

In accordance with the foregoing, claim 7 has been amended. No new matter has been submitted.

Claims 1-15 are pending and under consideration.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 3-4, the Examiner rejects claims 1, 5, 10 and 14 under 35 U.S.C. §103 over Yamamoto (Japan publication No. 8-267851) in view of Edmonds (U.S. Patent No. 6,748,183). The rejection is respectfully traversed and reconsideration is requested.

The Office Action has indicated that Yamamoto fails to disclose a determining whether a menu for designating a paper type for the cassette is displayed on a user interface of the output apparatus. The Office Action further asserts that Edmonds sets forth: "in response to the users' request for a print job, the query routine queries the printer for the status of the media in the printer trays," which may mean in response to opening up the printer for status of the media in the printer" trays. This status information is displayed in the user interface for each media tray." The Examiner subsequently indicates that the combination of Yamamoto and Edmonds would disclose "a system...with status updates of papers used in an image forming apparatus."

However, even if the Office Action's assertion is correct, the combination still fails to disclose "determining whether a menu for designating a paper type for the cassette is displayed on a user interface of the output apparatus," which is not the same as the Office Action's proffered "status updates." Therefore it is respectfully submitted that neither Yamamoto nor Edmonds, either alone or in combination, teach or suggest how to combine the method of designating a paper type after loading paper in an output apparatus recited in claim 1.

As commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art... "[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

Further, it is well settled that "the Board cannot simply reach conclusions based on its own understanding of experience - or on its assessment of what would be basic knowledge or common sense. Rather the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir.

2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "common knowledge" and "common sense" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings.

The relied upon motivation in the Office Action is merely that the proffered modification would have been obvious "for more efficiency." It would appear that this motivation is more of a conclusion than concrete evidence, i.e. it is more of the Examiner's opinion rather than evidence supported by the record.

Accordingly, this recited motivation "for more efficiency" fails to support a prima facie obviousness case. There is concrete evidence in the record supporting the additional efficiency of the added feature, for the primary reference. Further, there is no concrete evidence in the record that the primary reference would need, desire, or even be capable of accepting the suggested additional feature.

Further, claims 5, 10, and 14, which include at least similar recitations to those of claim 1, with differing scope and breadths, are submitted to be allowable for at least similar reasons to those of claim 1.

OBJECTION OF CLAIMS 2-4 AND 7:

At page 4 of the Office Action, claims 2-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As noted above, claims 2-4, also which ultimately depend from claim 1, should also now be allowable.

Further, we amended claim 7 to overcome the objection and it should also now be allowable.

OBJECTION TO SPECIFICATION:

In accordance with the above amendment to the Abstract, withdrawal of this objection is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

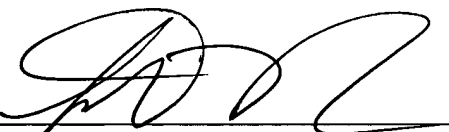
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 12/27/04

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